

Remarks

The Office Action of Oct. 18, 2007 rejected pending claims 1 and 5 (both as amended) under sec. 103, in view of alleged "admitted prior art" combined with Ahlstone. This Reply amends only Claim 5 (with Claim 1 remaining as amended in the reply of Jul. 23, 2007).

The Sec. 103 Rejections

The Office Action rejects the pending claims, under sec. 103. The sec. 103 rejections are based on a proposed combination of Ahlstone and the structure shown in the submitted drawings as admittedly prior art. As set out in previous responses, Applicant disputes the propriety of the proposed combination. It is settled law that there must be some suggestion in the references themselves or the prior art to suggest the combination. A Sec. 103 rejection based on a combination of references requires a prima facie case of obviousness, which in turn has three basic criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the prior art references must teach or suggest all of the claim limitations. MPEP 706.02(j); 2143. As established by *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000): particular factual findings to support each element must be provided; broad conclusory statements alone are not "evidence." The test for whether a prima facie case exists cannot be satisfied by unsupported statements that a person having ordinary skill in the art would find it obvious to combine references; the Federal Circuit has specifically held that the basis for combining references cannot be met as arising out of "common knowledge" or "common sense." *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Applicant sees no suggestion of a combination, and specifically requests that any future office action rejecting any claims under sec. 103 in view of a combination of references to give

specific factual support for said combination.

Addressing the claim rejections and the claims in more detail:

Claims 1 and 5 were rejected under sec. 103 “as being unpatentable over Ahlston in view of admitted prior art.” Applicant respectfully disagrees.

In Ahlstone, the Office Action refers to Fig. 5, element 70' (as element 70, as shown in Fig. 2, clearly discloses a symmetric jaw insert, which could not constitute a sec. 102 bar to Claim 1). Element 70' is briefly described at Col. 6, lines 30 – 39, as “A second set of jaw inserts 70', one of which is illustrated in Fig. 5, is shaped so as to extend further in a radially inward direction towards the center of the ring gear for engaging a range of small diameter tubes, for example, 1.315 inches to 3.69 inches outside diameter.” Beyond this brief written description, and the drawing in Fig. 5, Applicant is left to guess at exactly what structure Ahlstone in fact discloses. Applicant submits that the disclosure of elements 70' of Ahlstone, therefore, does not disclose the invention claimed in Claim 1 as amended; in view of the absence of any sec. 102 rejections in the present Office Action, Applicant believes that that point is undisputed. The present invention has a function of permitting a *wider range* of tubulars to be gripped, by the shape and geometry of the tong die, and the fact that it comprises a gripping surface portion along substantially the entirety of its surface.

Ahlstone, by contrast, discloses that the alternate jaw insert 70' is for a *smaller* tubular – *not* a wider range – and in fact a careful examination of Fig. 5 appears to show that element 70' has a teeth only on that portion which would bear against a relatively small diameter tubular, where the jaw is rotated a relatively large degree toward the center of the back-up tong. In fact, from Fig. 5, the apparatus of Ahlstone appears to be inoperable for larger diameter tubulars, since that portion of element 70' which would contact a larger diameter tubular has no teeth (please see Attachment 1, which shows the attributes of element 70' referred to herein). Claim

1, as amended, is therefore clearly not disclosed by Ahlstone, and further is not obvious in view of the proposed combination of Ahlstone and the admitted prior art. Ahlstone apparently also did not appreciate the attribute of Claim 1, as amended, which enables the effective gripping of a wide *range* of tubulars.

There is no suggestion in Ahlstone supporting the combination with a “hook type” backup

Further, Applicant notes the following important distinction between Ahlstone and the invention of Claim 1, as amended. Ahlstone clearly discloses a tool in which *three* jaw/die combinations rotate to bear against the tubular being gripped. Claim 1, as currently amended, and consistent with the disclosure herein, provides a backup unit having a hook shaped member therein, and in which the tubular is forced into the hook shaped member by contact with a single die/rotatable jaw assembly. Ahlstone describes in some detail (see Col. 2, about lines 32 - 59) how that invention is directed toward a “Foster-style,” multiple jaw (non-hook type) backup tong.

Applicant respectfully asserts that the invention of Claim 1, as amended, is non-obvious over the asserted reference, and therefore patentable.

Claim 5 has been amended. Applicant invites the Examiner’s attention to the argument above related to Claim 1, as to the Ahlstone reference, and adopts those arguments with regard to Claim 5, as well. Additionally, and of key importance, Claim 5 claims a tong assembly, comprising the hook shaped member in combination with the novel tong die shape of the present invention, and wherein only a single rotatable jaw/die assembly contacts the tubular at any time. Applicant respectfully submits that the proposed combination of Ahlstone and the acknowledged prior art neither discloses nor suggests a tong assembly, comprising a backup having a hook shaped member therein, wherein only a single rotatable jaw/die assembly

contacts the tubular, and wherein the die has the novel shape set out herein. Claim 5 has further been amended to particularly claim the tong assembly having first and second jaws and dies, where a first die contacts the tubular when backup force is needed in a first direction; and a second die contacts the tubular when backup force is needed in a second direction, *without* the need to “flip the backup tong over.” Ahlstone, in contrast, discloses a backup in which all three jaws can provide backup force for only a single direction of rotation (e.g., backup force when the tubular is being screwed together). If backup force is needed in the opposite rotational direction, then Ahlstone must be “flipped over,” as described in Col. 7, lines about 14 through 40. The suspension block 108 “provides two degrees of freedom to the tong 40, i.e. the entire tong 40 is free to turn about a longitudinal axis of the stem tail 104 [i.e. “flipped over”] relative to the suspension block 108.” Fig. 2, reference line 7A, appears to illustrate this rotation of the backup tong of Ahlstone.

The invention of Claim 5 avoids the need to “flip over” the tong. When backup force in an opposite direction is needed, the backup tong of the claimed invention is simply situated so that the opposite tong jaw/die contacts the tubular, which moves into the opposite corner of the hook.

For all the above reasons, Applicant asserts that Claim 5, as amended, is patentable over the cited reference.

Conclusion

For all of the above reasons, Applicant submits that the claims are in proper form and define patentable subject matter over the cited prior art. Therefore, Applicant respectfully requests allowance thereof.

Applicant further respectfully requests early consideration of this Amendment/Reply, and allowance of the claims thereafter. Should the Examiner believe that a telephonic interview would

be helpful in resolving any further questions, please contact the undersigned at the listed telephone number.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jesse D. Lambert", is written over a horizontal line.

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